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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,161	03/01/2004	Masao Nakano	848075/0066	3406

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SCHULTE ROTH & ZABEL LLP
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NEW YORK, NY 10022

EXAMINER

LESPERANCE, JEAN E

ART UNIT	PAPER NUMBER
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2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/791,161

Applicant(s)

NAKANO ET AL.

Examiner

Jean E. Lesperance

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/6/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The application filed March 1, 2004 is presented for examination and claims 1-17 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent # 5,859,628 ("Ross et al.") in view of US Patent # 6,553,379 ("Jaeger et al.").

Regarding claim 1, Ross et al. teach a personal digital assistant having a display responsive to a touch operation (PDA 102 is shown with a touch-responsive screen 202 for displaying characters or touch-responsive keys (column 4, lines 6-8)) comprising:

an operation signal in response to the turning or pushing operation of said control switch (Illumination of screen 202 by lamp 106 is accomplished automatically through use of a photosensor (not shown) measuring ambient light or manually by depressing a switch. In the latter case, lamp 106 is turned on by momentarily pressing a button on cradle 104. Electronic circuits turn on lamp 106 until the button (not shown) is pressed again, or until a fixed period of time elapses.(column 4, lines 41-50));

a judging means which judges whether said touch operation to said display is done or said control switch is operated (processor Fig.4 (404)) which detects when the display is touched;

a display control means which performs a first page transition control for transitioning an operation page displayed on said display in accordance with said touch operation when said judging means judges that said touch operation is done to said display, or performs a second page transition control for transitioning said operation page displayed on said display part in accordance with said operation signal (the touch-responsive screen 202 includes a means for selecting or designating a location on the surface of screen 202 in response to a pointing device being placed on the surface of screen 202 (column 4, lines 8-12)) where when the pointing device selects an item on the display there is a transition from the present display screen to the next screen as seen in Figs.6A to 6D. Accordingly, the prior art teaches all the claimed limitations with the exception of providing a control switch which can be turned and pushed-in.

However, Jaeger et al. teach the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)).

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the rotary switch 22 as taught by Jaeger et al. in the PDA disclosed by Ross et al. because this would provide a way to navigate the PDA system.

Regarding claim 2, Jaeger et al. teach a plurality of items are displayed on said operation page as selection items, and said display control means performs the selection of an item from said selection items in accordance with the operation signal when said control switch is turned and said second page transition control whereby the page is transitioned to said operation page pertinent to the item selected in accordance with the operation signal when said control switch is pushed (the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)) where the control switch can select any item on the display and more.

Regarding claims 3 and 4, Jaeger et al. teach said display control means allows a cursor to move on said operation page in the direction corresponding to the turning direction of said control switch (the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)) where the control switch can select any item on the display and more.

Regarding claim 5, Jaeger et al. teach said display control means performs the selection of an item from the selection items among the items displayed in said operation page as selection items when said control switch is turned and said second page transition control is performed when said control switch is pushed whereby said page is transitioned to said operation page pertinent to said selected item (the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22

(column 6, lines 2-5)) where the control switch can be rotated and pressed select any item on the display and more.

Regarding claim 6, Jaeger et al. teach said display control means allows said cursor to move on said operation page in accordance with said turning operation of said control switch and said second page transition control changes to said page determined by the position of said cursor by pushing said control switch(the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)) where the control switch can be rotated and pressed select any item on the display and more.

Regarding claim 7, Jaeger et al. teach said control switch is supported on a shaft extending in a direction so that said control switch is rotatable in a certain range of angle from a reference position of rotation and can be pushed in to a direction perpendicular to the direction of rotation at said reference position of rotation (the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)) where the control switch can be seen in Fig.1 is rotatable and of course inherently has a shaft to be rotated therein and pushed to select any item on the display and more.

Regarding claim 8, Ross et al. teach said display part is positioned on a front face of an encasement of said personal digital assistant (PDA 102 is shown with a touch-responsive screen 202 for displaying characters or touch-responsive keys

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(column 4, lines 6-8)) where the display 102 is in the front of the PDA.

Regarding claim 9, Jaeger et al. teach an escape switch is provided on said side of the encasement of the personal digital assistant, and when said escape switch is pushed said display control means carries out page return from said operation page after transition to said page before transition rotation (the user has then the possibility to move the cursor from one address data record to the next by the use of the rotary switch 22 and to make a selection by pushing the rotary switch 22 (column 6, lines 2-5)) where the control switch can be seen in Fig.1 is rotatable and of course inherently has a shaft to be rotated therein and pushed to select any item on the display and more.

Regarding claim 10, it is rejected on the same rational as claim 1.

Regarding claim 11, it is rejected on the same rational as claim 1.

Regarding claims 12, it is rejected on the same rational as claim 1.

Regarding claim 13, Ross et al. teach Fig.6B with a plurality of columns where Gas is being the first operation page and Motel being the second operation page.

Regarding claim 14, it is rejected on the same rational as claim 1.

Regarding claim 15, it is rejected on the same rational as claim 1.

Regarding claim 16, it is rejected on the same rational as claim 1.

Regarding claim 17, it is rejected on the same rational as claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Lesperance whose telephone number is (571) 272-7692. The examiner can normally be reached on from Monday to Friday between

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10:00AM and 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to:

(571) 273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Jean Lesperance


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Date 12/21/2006



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600